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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,514	05/01/2006	Naoshi Masukawa	124639	2015
25944 7590 06/25/2009 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
O HERN, BRENT T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
06/25/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/541,514

**Applicant(s)**

MASUKAWA ET AL.

**Examiner**

Brent T. O'Hern

**Art Unit**

1794

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1 and 3-9.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/BTO/  
Brent T. O'Hern  
Examiner, Art Unit: 1794

/Elizabeth M. Cole/  
Primary Examiner, Art Unit 1794

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive as the claims are taught by the prior art of record.

In response to Applicant's arguments (See paras. I-II, pp. 2-3 of Applicant's Paper filed 6/15/2009.) that Yoshida ('922) does not teach the range of between 1.0 and 7.3 per equation #1 per independent claim #1 because Yoshida only teaches the broad range of 0.0625 to 30, it is noted that Yoshida teaches values that are within the specific range as claimed. Applicant admits that Yoshida teaches the 0.0625 to 30 range for L values of 1 to 100  $\mu\text{m}$  (See the bottom of p. 5 of Applicant's Paper filed 1-15-2009 and in Para. II noted above.). As can be seen at para. 60 and throughout the disclosure of Yoshida, the L values can be 20  $\mu\text{m}$  and other values. Thus, when using Applicant's calculations the value per equation #1 is 6 which is clearly within the claimed range of 1.0 to 7.3. Thus, Applicant's assertions that Yoshida just teaches the far ends of the above range is not accurate as Yoshida clearly teaches values within the claimed range. Applicant does not consider the teachings of Yoshida as a whole.

In response to Applicant's arguments (See para. III, pp. 3-4 of Applicant's Paper filed 6/15/2009.) that Applicant's previous arguments are based on well-established law because a genus does not teach a species, it is firstly noted that this case does not involve a genus/species relationship. Furthermore, as discussed above, Yoshida not only teaches the entire range as claimed but also teaches specific values within the claimed range. Thus, even if Applicant's arguments are persuasive regarding the broader teachings, Yoshida also teaches specific values with the claimed range that Applicant does not address.

In response to Applicant's arguments (See para. IV, pp. 4-6 of Applicant's Paper filed 6/15/2009.) that the Office's statements are unreasonable regarding criticality because it is unreasonable for Applicant to show that Yoshida must have a range outside the claimed range, it is noted as discussed above that even using Applicant's calculations, Yoshida not only teaches values broader than those claimed but also values within the claimed range. As discussed above, Applicant does not address the expressed teachings of Yoshida having values within the specific range as claimed.

In response to Applicant's arguments (See para. V, p. 6 of Applicant's Paper filed 6/15/2009.) that Yoshida does not teach the narrow range as claimed, it is noted as discussed above that Yoshida teaches values specifically within the claimed range.

/BTO/  
Brent T. O'Hern  
Examiner, Art Unit: 1794